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09/995,482	11/28/2001	Michael J. McKay	Leichtag001C	3333

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THE MATTHEWS FIRM
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Houston, TX 77027

EXAMINER

JONES, SCOTT E

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 12/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,482

Applicant(s)

MCKAY ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on September 16, 2003 in which applicant amends claims 17, 18, and 21, cancels claims 22 and 27-34, submits formal drawings, and responds to the claim rejections. Claims 17-21 and 23-26 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (U.S. 5,906,371) in view of Links 386CD Players Manual.

Peterson discloses a multi-skill question and answer board game played by players of different skill and age levels. The game can improve player's skills in various educational subject matter. Additionally, an age factor is applied to a player's point total to compensate for

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any age difference between competing players. Furthermore, the educational board game can be implemented in a computer-based format. Peterson discloses:

Regarding Claim 17:

- displaying a game board on a computer screen (figure 1);
- providing a game piece for each of said names of said actual player listing (column 1, line 5);
- asking a random question in turn to a given player on said actual player listing as the game piece of said given player is moved to a predetermined location (column 2, lines 18-20);
- inputting by said given player an answer to said random question (column 2, lines 18-20);
- allowing the game piece of said given player to remain in said predetermined location only if the answer to said random question is correct (column 1, lines 49-51). Milton Bradley's GO TO THE HEAD OF THE CLASS™ discloses this feature.

Regarding Claim 18:

- adjusting said score based on each name of said actual player listing based upon the respective age of each of said actual players (column 2, lines 46-51).

Peterson seems to lack explicitly stating:

Regarding Claim 17:

- inputting names of a plurality of players to a potential players listing;

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- selecting names from said potential players listing for playing or not playing a subsequent game to thereby produce an actual player listing;
- electronically storing said names and ages of said potential players listing such that said names and ages are available for all subsequent games without reentering said names and ages except for respective of said names and ages that are selectively deleted from said potential players listing;
- automatically moving a game piece on said game board for each of said names of said actual player listing; and
- automatically accumulating a score for each name of said actual player listing.

Links 386CD Players Manual teaches of a software program that executes instructions to play a game on a computer. Peterson and Links 386CD Players Manual are analogous art because each are relating to games that can be implemented in a computer-based format.

Furthermore, Links 386CD Players Manual teaches of:

Regarding Claim 17:

- inputting names of a plurality of players to a potential players listing (pp. 19-20);
- selecting names from said potential players listing for playing or not playing a subsequent game to thereby produce an actual player listing (pp. 19-20) ;
- electronically storing said names of said potential players listing such that said names are available for all subsequent games without reentering said names except for respective of said names that are selectively deleted from said potential players listing (pp. 19-20).

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It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the creating new players and choosing players for a round feature of Links 386CD Players Manual in the computer-based implementation of Peterson. One would be motivated to do so because players would not have to input personal information (name and age) each time a game was played and would only have to select from a list of potential players to play a game. Furthermore, to one having ordinary skill in the art, it would have been obvious at the time of applicant's invention to input a player's age in Peterson's computer-based implementation. Doing so, a programmer could easily program the game to automatically adjust a player's score based on an age factor input into the game system.

Furthermore, regarding claim 17, to one having ordinary skill in the art, well known programming techniques to automatically move a game piece on said game board for each of said names of said actual player listing; and automatically accumulating a score for each name of said actual player listing could be implemented in Peterson's computer-based implementation. One would be motivated to do so because these features would automate the process of the game, rather than relying on humans to manually move game pieces or tally player scores.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (U.S. 5,906,371) in view of Links 386CD Players Manual and further in view of Freda, III (U.S. 5,660,389).

Peterson in view of Links 386CD Players Manual teaches that as discussed above regarding claims 17 and 18. Peterson in view of Links 386CD Players Manual seems to lack explicitly teaching:

Regarding Claim 19:

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- automatically and randomly selecting mystery positions on said game board such that mystery positions are not visible on said computer screen, and
- asking a plurality of random bonus questions when said respective player lands on said mystery position.

Freda, III teaches of a trivia game with a weighted scoring system that can be implemented in software to be played on a computer. Freda III, Peterson, and Links 386CD Players Manual are analogous art because each are relating to games that can be implemented in a computer-based format. Furthermore, Freda, III teaches:

Regarding Claim 19:

- selecting mystery positions (10) on said game board on said computer screen (figure 1, column 5, lines 24-30, and column 8, lines 21-48); and
- asking a plurality of random bonus questions when said respective player lands on said mystery position (column 8, line 49-column 9, line 7).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Freda's bonus markers and questions in Peterson in view of Links 386CD Players Manual. One would be motivated to do so because the first player to reach the graduation space with the highest I.Q. wins the game. Therefore, the bonus questions would enable a player to earn extra points to add to the player's I.Q. value.

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (U.S. 5,906,371) in view of Links 386CD Players Manual and further in view of Ho et al. (U.S. 6,120,300).

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Peterson in view of Links 386CD Players Manual teaches that as discussed above regarding claims 17 and 18. Peterson in view of Links 386CD Players Manual seems to lack explicitly teaching:

Regarding claim 20:

- awarding said respective player with an attractive certificate.

Ho et al. teaches of a reward based computer-aided educational system that provides individual rewards for a player when they reach a milestone. Ho et al., Peterson and Links 386CD Players Manual are analogous art because each are relating to games that can be implemented in a computer-based format. Furthermore, Ho et al. teaches:

Regarding claim 20:

- awarding said respective player with an attractive certificate (column 14, lines 2-40).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the award features of Ho et al. in Peterson in view of Links 386CD Players Manual. One would be motivated to do so because a player could enjoy an individualized printed certificate upon winning Peterson's game further enriching a player/students learning process through rewards.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (U.S. 5,906,371) in view of Freda, III (U.S. 5,660,389).

Peterson discloses a multi-skill question and answer board game played by players of different skill and age levels. The game can improve player's skills in various educational subject matter. Additionally, an age factor is applied to a player's point total to compensate for

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any age difference between competing players. Furthermore, the educational board game can be implemented in a computer-based format. Peterson discloses:

Regarding claim 21:

- displaying a game board on a computer screen (figure 1);
- displaying a game piece for each player (column 1, line 5);
- asking the same random question to each player, each of said random questions having ranging difficulty, from one question to the next (column 2, lines 18-20);
- allowing the game piece of said given player to remain in said predetermined location only if the answer to said random question is correct (column 1, lines 49-51). Milton Bradley's GO TO THE HEAD OF THE CLASS™ discloses this feature;
- inputting an answer to said random question by each player (column 2, lines 18-20).

Peterson seems to lack explicitly disclosing:

Regarding Claim 21:

- automatically and randomly selecting one or more mystery positions on said game board such that mystery positions are not visible on said computer screen, and
- asking at least one random bonus question when each player lands on said mystery positions.

Freda, III teaches of a trivia game with a weighted scoring system that can be implemented in software to be played on a computer. Freda III, and Peterson are analogous art

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because each are relating to games that can be implemented in a computer-based format.

Furthermore, Freda, III teaches:

Regarding Claim 21:

- automatically and randomly selecting one or more mystery positions (10) on said game board such that mystery positions are not visible on said computer screen (figure 1, column 5, lines 24-30, and column 8, lines 21-48), and
- asking at least one random bonus question when each player lands on said mystery positions (column 8, line 49-column 9, line 7).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Freda's bonus markers and questions in Peterson. One would be motivated to do so because the first player to reach the graduation space with the highest I.Q. wins the game. Therefore, the bonus questions would enable a player to earn extra points to add to the player's I.Q. value.

Furthermore, regarding claim 21, to one having ordinary skill in the art, well known programming techniques to automatically move a game piece on said game board for each of said names of said actual player listing; and automatically accumulating a score for each name of said actual player listing could be implemented in Peterson's computer-based implementation. One would be motivated to do so because these features would automate the process of the game, rather than relying on humans to manually move game pieces or tally player scores.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (U.S. 5,906,371) in view of Freda, III (U.S. 5,660,389) and further in view of Walker et al. (U.S. 5,921,864).

Peterson in view of Freda, III teaches that as discussed above regarding claims 21 and 22.

Peterson in view of Freda, III seems to lack explicitly teaching:

Regarding claim 23:

- providing a score for a question based on a length of time required for inputting an answer.

Walker et al. teaches of an electronic word puzzle game that can be played on a computer wherein the computer scores a player's performance based on time elapsed to answer the puzzle correctly. A higher score is indicative of a faster time to solution, that is, if the predetermined time period expires, the player's final score will be reduced to zero. Walker et al. teaches:

Regarding claim 23:

- providing a score for a question based on a length of time required for inputting an answer (column 4, lines 44-56).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Walker's feature having a player's performance based on the time elapsed to answer question correctly in Peterson in view of Freda, III in order to add another dimension to the game making the game even more competitive.

9. Claims 24, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (U.S. 5,906,371) in view of Freda, III (U.S. 5,660,389) and further in view of Links 386CD Players Manual.

Peterson in view of Freda, III teach that as discussed above regarding claim 21. Peterson in view of Freda, III seem to lack explicitly stating:

Regarding Claim 24:

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- inputting names of a plurality of players to a potential players listing.

Regarding Claim 25:

- selecting names from said players listing for playing or not playing a subsequent game to thereby produce an actual player listing;
- electronically storing said names of said potential players listing such that said names are available for all subsequent games without reentering said names except for respective of said names that are selectively deleted from said potential players listing.

Links 386CD Players Manual teaches of a software program that executes instructions to play a game on a computer. Peterson, Freda, III, and Links 386CD Players Manual are analogous art because each are relating to games that can be implemented in a computer-based format. Furthermore, Links 386CD Players Manual teaches of:

Regarding Claim 24:

- inputting names of a plurality of players to a potential players listing (pp. 19-20).

Regarding Claim 25:

- selecting names from said players listing for playing or not playing a subsequent game to thereby produce an actual player listing (pp. 19-20);
- electronically storing said names of said potential players listing such that said names are available for all subsequent games without reentering said names except for respective of said names that are selectively deleted from said potential players listing (pp. 19-20).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the creating new players and choosing players for a round feature of Links 386CD Players Manual in the computer-based implementation of Peterson in view of Freda, III. One would be motivated to do so because players would not have to input personal information (name and age) each time a game was played and would only have to select from a list of potential players to play a game. Furthermore, to one having ordinary skill in the art, it would have been obvious at the time of applicant's invention to input a player's age in Peterson's computer-based implementation. Doing so, a programmer could easily program the game to automatically adjust a player's score based on an age factor input into the game system.

Response to Arguments

10. Applicant's arguments filed September 16, 2003 have been fully considered but they are not persuasive.

11. Applicant respectfully traverses the rejections to claims 17-21 and 23-26 under 35 U.S.C. 103 based on varying combinations of four United States patents and references, viz, Peterson (U.S. 5,906,371), Links 386CD Players Manual, Freda, III (U.S. 5,660,389), Ho et al. (U.S. 6,120,300), and Walker et al. (U.S. 5,921,864). Applicant alleges "it seems inappropriate for the Examiner to combine four or five references to reject any claim, because given enough references to combine, there is no invention which would ever be patentable under 35 U.S.C. 103." However, the examiner respectfully disagrees. The examiner contends the features found in the references are very well known in the gaming arts. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed

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invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Additionally, other than a general statement traversing the rejections, Applicant does not argue why the instant invention is not rendered obvious over the combinations of references as stated in Office Action, Paper No. 7. Therefore, the examiner believes Applicant has acquiesced to the examiner's previous rejections by virtue of not responding specifically to each rejection.

To overcome the rejections, Applicant has amended independent claims 17 and 21 to include the limitation, "allowing the game piece of said given player to remain in said predetermined location only if the answer to the random question is correct." Applicant alleges the claim feature is novel and is not taught, disclosed, or suggested in any patent or references cited. However, the examiner respectfully disagrees. The examiner relies on Peterson (U.S. 5,906,371) as the base reference in the rejections to independent claims 17 and 21. In the prior art section, Peterson discloses Milton Bradley's GO TO THE HEAD OF THE CLASS™ game. In GO TO THE HEAD OF THE CLASS™, if a player lands on a desk with a "homework" assignment (question/answer) and answers the question incorrectly (has a poor grade), then the player is sent back. The prior art of record, Peterson, discloses this feature, and therefore, the examiner believes the claims of the instant invention are rendered obvious over the prior art.

12. Applicant's arguments, see page 10, filed September 16, 2003, with respect to the rejection to claims 17-21 and 23-26 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The rejection of claims 17-21 and 23-26 under 35 U.S.C. 112, second paragraph has been withdrawn.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Education Learning Board Games – go to the head of the class game – kids board game discloses the rules for Milton Bradley's GO TO THE HEAD OF THE CLASS™ game. In GO TO THE HEAD OF THE CLASS™ game.
- Carrera et al. (U.S. 4,273,337) discloses a family sex education board game wherein if a player answers a question correctly, then the player moves to the predetermined location. However, if the player answers the question incorrectly, then the player remains in the same space.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ

sej

A handwritten signature in black ink, appearing to read 'm u o n e i l l', written in a cursive style.

**MICHAEL O'NEILL
PRIMARY EXAMINER**